

REMARKS

Claims 1-13 and 15-26 are pending in the application upon entry of the amendments and new claims. Claim 14 has been canceled without prejudice or disclaimer. Claims 1-5, 8-13, 15, 16, and 18-21 have been amended for consistency and to better describe certain aspects of the invention. Claims 24-26 have been added to further describe the invention. Favorable reconsideration in light of the amendments, the new claims, the Terminal Disclaimer, and the remarks which follow is respectfully requested.

The Objections to the Specification and Claims

The specification and claims have been objected to. The specification and claims have been amended as suggested by the Examiner to, for example, cure any informalities. Withdrawal of these objections is respectfully requested.

The Indefiniteness Rejection

Claims 3, 4, 8, 11-15, 20, and 21 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention. Claims 3, 4, 8, 11-13, 15, 20, and 21 have been amended as suggested by the Examiner.

The Double Patenting Rejection

Claims 1-23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of co-pending Application No. 10/772,473. The subject application and Application No. 10/772,473 are owned by the same entity, Taskem, Inc. (see Reel/Frame 014967/0456 for Application No. 10/772,473). The enclosed Terminal Disclaimer renders this rejection moot.

The Rejection Under 35 U.S.C. §102(b)

Claims 1-4 stand rejected under 35 U.S.C. §102(b) as being anticipated by JP 10-245693 (hereinafter "JP '693"). Independent claim 1 has been amended to recite an acetylenic brightener. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. JP '693 does not describe, teach or suggest each and every feature of the subject claims.

To establish anticipation, each and every claim feature must be disclosed in a single cited art document. JP '693 relates to forming a nickel alloy by electroplating. JP '693 requires a N-heterocyclic quaternary ammonium salt as a brightener. In JP '693, there is no disclosure, teaching or suggestion to employ an acetylenic brightener required in claim 1. JP '693 does not disclose any quaternary alloys electroplated with an acetylenic brightener. Since JP '693 fails to disclose, teach, or suggest all of the claimed features, JP '693 cannot anticipate claims 1-4 and furthermore cannot render claims 1-4 obvious.

The Rejection Under 35 U.S.C. §103(a)

I. Claims 5-8 have been rejected under 35 U.S.C. § 103(a) over JP '693 in view of Hui (US Patent No. 6,372,118). Independent claim 1 from which claims 4-8 depend has been amended to recite an acetylenic brightener.

To establish a *prima facie* case of obviousness, three basic criteria must be shown. First, there must be some suggestion or motivation, either in the cited art or in the knowledge generally available to one of ordinary skill in the art, to modify the cited art or to combine the cited art. Second, there must be a reasonable expectation of success. Finally, the cited art must teach or suggest all the claim features. See MPEP 706.02(j).

JP '693 does not teach or suggest the claimed features of independent claim 1 as noted *supra*. JP '693 does not disclose any quaternary alloys electroplated with an acetylenic brightener. As the Examiner concedes, JP '693 also does not disclose specific current density and concentrations of metals required in claim 1. Hui fails to

teach employing an acetylenic brightener for electroplating an quaternary alloy. Hui fails to make up for the aforementioned deficiencies of JP '693. The asserted combination of JP '693 and Hui does not teach or suggest all the claim features. Accordingly, this rejection should be withdrawn.

II. Claims 9-13 and 15-17 have been rejected under 35 U.S.C. § 103(a) over JP '693. Independent claim 9 has been amended to recite an acetylenic brightener. JP '693 does not disclose any quaternary alloys electroplated with an acetylenic brightener. As the Examiner concedes, JP '693 also does not disclose specific current density and concentrations of metals required in claim 1. Since JP '693 fails to disclose, teach or suggest all of the claimed features, JP '693 cannot render claims 9-13 and 15 obvious. Accordingly, this rejection should be withdrawn.

III. Claim 14 has been rejected under 35 U.S.C. § 103(a) over JP '693 and in view of Hui. Claim 14 has been canceled without prejudice or disclaimer.

IV. Claims 18-23 have been rejected under 35 U.S.C. § 103(a) over JP '693. Independent claim 16 has been amended to recite an acetylenic brightener. JP '693 does not disclose any quaternary alloys electroplated with an acetylenic brightener. Furthermore, as the Examiner concedes, JP '693 does not disclose at least two brighteners selected from the group consisting of sulfur containing brighteners and acetylenic brighteners. Since JP '693 fails to disclose, teach or suggest all of the claimed features, JP '693 cannot render claims 9-13 and 15 obvious. Accordingly, this rejection should be withdrawn.

Petition for Extension of Time

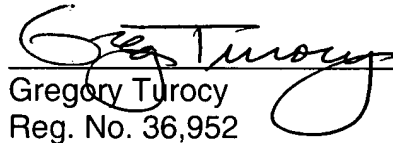
A request for a one month extension of time is hereby made (small entity status has been established). A Credit Card charge form is enclosed herewith to pay the petition fees.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-1063.

Respectfully submitted,

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